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10/517,346

12/09/2004

Tzvi Stein

STEIN8

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BROWDY AND NEIMARK, P.L.L.C.  
624 NINTH STREET, NW  
SUITE 300  
WASHINGTON, DC 20001-5303

EXAMINER

NICKERSON, JEFFREY L

ART UNIT

PAPER NUMBER

4117

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/517,346

Applicant(s)

STEIN ET AL.

Examiner

Jeffrey Nickerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 27 May 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This communication is in response to Application No. 10/517,346 filed on 9 December 2004. The preliminary amendment, which provides change to claims 1, 4-9, 13, 15-19, and 21, cancels claims 22 and 23, and adds claims 24 and 25, is hereby acknowledged. Claims 1-21 and 24-25 have been examined.

### ***Priority***

2. The later-filed application must be an application for a patent for an invention that is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/414,254, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Claims 1-21 and 24-25 either contain limitations or depend on a claim that contains limitations that are not enabled by the provisional application. As such, the claim for domestic priority will not be applied for the currently claimed subject matter in

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the aforementioned claims. Any future amendments that provide change to the claims will be examined for enablement with regard to the provisional application and will be granted the benefit of priority only if the examiner finds that they are enabled by the provisional application. The examiner will note whether a claim is enabled by the subject matter in the provisional application.

Regarding claim 1, the provisional application teaches using hierarchy layers and organizational routes to block/allow email traffic. The provisional does not teach measuring relative organizational distance, nor does it teach assigning an importance class as a function of the distance.

Regarding claims 2-8 and 18, these dependent claims have a parent claim that is not enabled by the provisional application. Also, claims 2-4, 6-8, and 18 contain limitations that are not enabled by the provisional application.

Regarding claim 9, the provisional application does not teach assigning importance classes.

Regarding claims 10-17, these dependent claims have a parent claim that is not enabled by the provisional application. Also, claims 10-17 contain limitations that are not enabled by the provisional application.

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Regarding claims 19, the provisional application does not teach assigning an importance class based on relative distance.

Regarding claims 20-21, these dependent claims have a parent claim that is not enabled by the provisional application. Also, claims 20-21 contain limitations that are not enabled by the provisional application.

Regarding claim 24, the provisional application does not teach assigning importance classes based on relative organizational distance.

Regarding claim 25, the provisional application does not teach assigning importance classes based on relative organizational distance.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 60 (Figures 2, 3, 4, and 7) and 530 (Figure 7). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the

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immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities: incorrect spelling or grammar, or confusing sentences. Pg 2a, line 25 – pg 3, line 5 of the applicant submitted specification (Pre-grant publication: [0011]) contains sentences that are confusing in nature and should be rewritten. For example, the phrase "assigned by a system using the method to each of a group" is confusing as to whether the recipient is "assigned to each of a group" or whether the "method relates to each of a group." Also, the examiner recommends splitting the last sentence of that paragraph into two sentences and removing a comma. Suggested change: The term "assigning importance classes" relates to associating each of a group, consisting of at least one element, of electronic messages with an importance class attribute. Associating can be performed, for example, by means of embedding, tagging or any other acceptable linking method.

Appropriate correction is required.

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Applicant is advised that should claim 24 be found allowable, claim 25 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-5, 7-9, 16, 19-20, and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvitz (US 6,938,024 B1).

Regarding claim 1, Horvitz teaches a method of assigning importance classes (classification/cost benefit analysis value) to electronic messages (emails), the method comprising:

identifying a sender of an electronic message; (Horvitz: col 6, lines 8-18 specify sender information, implying identifying the sender)

identifying a recipient of the electronic message; (Horvitz: col 6, lines 8-18 imply identifying the recipient)

determining the relative organizational distance between the sender and the recipient; (Horvitz: col 6, lines 8-18 specify within a certain distance of an organizational tree)



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assigning the electronic message an importance class as a function of the relative organizational distance between the sender and the recipient; (Horvitz: col 6, lines 8-18 specify these are all possible inputs for the classifier)

wherein said function assigns the importance class (priority value) in inverse dependence on the relative organizational distance between the sender and the recipient; (Horvitz: col 6, lines 8-18 imply that being within the distance is a higher priority value; col 11, lines 15-18 further specifies that users close within the organizational structure are biased)

Regarding claim 2, Horvitz teaches a method wherein said function is further weighted by at least one of the following criterion:

a globally defined content criterion; (Horvitz: col 6, lines 8-18 specify message words and phrases)

a personally defined defined message sender criterion; (Horvitz: col 11, line 13 specifies family members)

a personally defined content criterion;

a plurality of rules formed by a machine-learning algorithm; (Horvitz: col 12, lines 42-56 specify watching the users' habits)

an analysis of email message headers. (Horvitz: col 11, lines 4-10)

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Regarding claim 3, Horvitz teaches wherein the at least one additional criterion is a function of content in the message subject field and/or in the message body; (Horvitz: col 6, lines 8-18 specify phrases and words in the message body)

Regarding claim 4, Horvitz teaches wherein assigning the electronic message an importance class includes analyzing actions taken by said recipient on receipt of said messages so as to establish a relative importance ascribed by the recipient to received messages. (Horvitz: col 12, lines 42-56 specifies watching the users' actions and adjusting decision-making)

Regarding claim 5, Horvitz teaches wherein said electronic message is an electronic mail message. (Horvitz: abstract specifies emails)

Regarding claim 7, Horvitz teaches wherein said electronic message is a converted voice message or pager message text data. (Horvitz: col 1, lines 28-30 specify forwarding to a pagers and cell phones)

Regarding claim 8, Horvitz teaches wherein the relative organizational distance between the sender and the recipient is determined from an organizational structure of a corporation (Horvitz: col 11, lines 15-18 specify managers implying a business) and said function is refined according to one or more of the following:

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a set of global control rules according to the organizational structure and the work affiliation among different departments and different hierarchical layers in the corporation establishing organizational distance as a function of distance between respective hierarchical layers of the sender and recipient and of distance between departments in a common hierarchical layer;

a set of control rules according to ad hoc work groups formed from time to time;

a global list of preferred originating addresses, external to the organization, from senders affiliated with the organization. (Horvitz: col 11, line 19 specifies external business contacts)

Regarding claim 9, Horvitz teaches a method for streamlining management of electronic messages, the method comprising:

assigning an importance class to each of said messages in inverse dependence on a relative organizational distance between a sender and recipient of the message. (Horvitz: col 6, lines 8-18; col 11, lines 15-18)

streamlining said message in a pre-determined manner in accordance with the respective importance class of each message. (Horvitz: col 6, lines 34-47 specify downloading based on the cost-benefit analysis, which is dependent on the priority value)

Regarding claim 16, Horvitz teaches a method including selectively transmitting email messages (Horvitz: Figure 2, item 202) from an email server's inbox (Horvitz: Figure 2,

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item 200) to a client computer's inbox (Horvitz: Figure 2, item 208), according to said importance class (Horvitz: Figure 3, item 312).

Regarding claim 19, this system claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 20, this system claim comprises limitations substantially similar to that of claim 2 and the same rationale of rejection is used, where applicable.

Regarding claim 24, this computer readable storage medium claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 25, this computer readable storage medium claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz (US 6,938,024 B1), and further in view of Brennan (US 2002/0071546 A1).

Regarding claim 6, Horvitz teaches a method wherein said electronic message could have multiple formats, such as email, text messages, etc. (Horvitz: abstract; col 1, lines 28-30)

Horvitz does not explicitly teach that the electronic message could be a fax.

Brennan, in a similar field of endeavor, teaches wherein the electronic message could be a facsimile message. (Brennan: [0002] admits that prior art uses facsimile messages)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the knowledge of Brennan for having a system capable of handling facsimile messages. The teachings of Brennan, when implemented in the Horvitz system, will enable one of ordinary skill in the art to handle fax messages in their email filtering system. One of ordinary skill in the art would be motivated to utilize the teachings of Brennan in the Horvitz system because "e-mail systems are integrated with other voice messaging systems." (Brennan: [0002]).

Regarding claim 18, the Horvitz/Brennan system teaches including using a graphical tool to define the organizational distance (Brennan: rank) between different entities (Brennan: users) within the organization. (Brennan: Figure 6; [0039])

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Regarding claim 12, the Horvitz/Brennan system teaches wherein the streamlining of messages includes sorting notifications of incoming messages (Brennan: [0049] specifies dispatching notifications) in a pre-determined order indicating the relative importance of said messages in respect with their assigned importance classes. (Brennan: [0042] specifies sorting based off the rank/metric)

Regarding claim 15, the Horvitz/Brennan system teaches being implemented on a copy of the message (Brennan: data representative) that is external to a central repository (Brennan: mail retrieval application/library) on which incoming messages are stored so as to enable uninterrupted service in the case that said method fails to operate or malfunction. (Brennan: [0030] implies the handling application that ranks, is separate from the retrieval library)

11. Claims 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz (US 6,938,024 B1), in view of Brennan (US 2002/0071546 A1), and in further view of Goldstein et al (US 2002/0198984 A1).

Regarding claim 10, the Horvitz/Brennan system teaches wherein the streamlining message includes displaying notifications of incoming messages characteristic of the respective importance class (Brennan: rank) of each message. (Brennan: [0049])

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Brennan does not teach wherein the notifications use colors to distinguish themselves.

Goldstein, in a similar field of endeavor, teaches wherein notifications (Goldstein: alerts) can have colors based on their importance class (Goldstein: severity) (Goldstein: [0131])

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Goldstein for having a system capable of distinguishing notifications based on colors. The teachings of Goldstein, when implemented in the Horvitz/Brennan system, will enable one of ordinary skill in the art to identify importance classes based off color. One of ordinary skill in the art would be motivated to utilize the teachings of Goldstein in the Horvitz/Brennan system in order to allow users to easily identify the type of notification being received.

Regarding claim 11, the Horvitz/Brennan/Goldstein system teaches wherein the streamlining the messages includes displaying in association with the notifications of incoming messages a distinctive tag (Goldstein: alert name) that is characteristic of the respective importance class of each message. (Brennan: [0049] specifies notifications; Goldstein: [0131] specifies using alert names)

12. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz (US 6,938,024 B1), in further of view of Baker et al (7,113,977 B1).

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Regarding claim 13, Horvitz teaches a method wherein streamlining the messages includes summarizing messages whose importance class is beneath the predetermined threshold. (Horvitz: col 7, lines 9-19 specify truncating the message based on the cost-benefit value)

Horvitz does not teach blocking the message.

Baker, in a similar field of endeavor, teaches wherein the message is blocked. (Baker: col 1, lines 52-55)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Baker for blocking the entire message. The teachings of Baker, when implemented in the Horvitz system, will enable one of ordinary skill in the art to filter email messages based on their importance/cost-benefit value. One of ordinary skill in the art would be motivated to utilize the teachings of Baker in the Horvitz system in order to "block receipt of undesirable mail". (Baker: col 1, lines 29-30)

Regarding claim 14, the Horvitz/Baker system teaches further including alerting the sender that a message has been blocked. (Baker: col 1, lines 58-62)

13. Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz (US 6,938,024 B1), and further in view of Voticky (WO 01/80535 A1).



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Regarding claim 17, Horvitz teaches assigning a cost-benefit value based off elapsed time. (Horvitz: col 10, lines 50-54)

Horvitz does not teach archiving the messages based off the value and thus the relative elapsed time.

Voticky, in a similar field of endeavor, teaches grouping messages residing in a user's inbox into archives (Voticky: virtual mailbox), according to their importance class (Voticky: pg 13, lines 14-26 specifies grouping based on priority) and an elapsed time since they were received. (Voticky: pg 14, lines 21-35 specifies further grouping based on the received time and date)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Voticky for grouping electronic messages based on their priority or importance. The teachings of Voticky, when implemented in the Horvitz system, will enable one of ordinary skill in the art to further group and organize messages based on their priority/cost-benefit value. One of ordinary skill in the art would be motivated to utilize the teachings of Voticky in the Horvitz system in order to "provide end-users with powerful tools to prioritize incoming communication". (Voticky: pg 3, lines 1-3)

Regarding claim 21, the Horvitz/Voticky system teaches a rules formation unit (Horvitz: classifier) comprising:

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a set of global control rules relating to an organizational structure and work affiliation among different departments and different hierarchical layers thereof; (Horvitz: col 11, lines 15-18)

a set of control rules relating to ad hoc work groups from time to time in said organizational structure; (Voticky: pg 17, lines 5-18 specify creating temporary priority alphanumeric codes (PAC))

a global list of preferred originating addresses external to the organizational structure. (Horvitz: col 11, line 19)

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

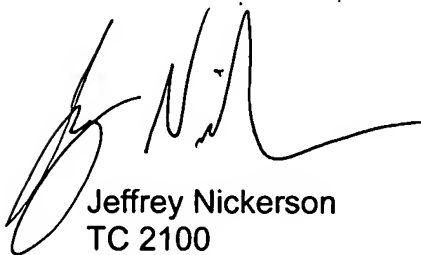
- a. Henderson et al (US 6,185,603 B1) discloses a system for alerting and delivering messages based on message content.
- b. Horvitz et al (US 6,901,398 B1) discloses a system and method for further adapting the classifier described in the cited patent.
- c. Ouchi et al (US 6,170,002 B1) discloses a system and method for managing the workflow process of electronic messages.

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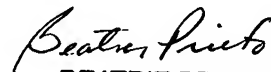
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Nickerson whose telephone number is 571-270-3631. The examiner can normally be reached on M-Th, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey Nickerson  
TC 2100  
Patent Examiner  
October 10, 2007



BEATRIZ PRIETO  
SUPERVISORY PATENT EXAMINER